



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,283	03/19/2001	Robert L. Fischer	023070086121	2808

20350 7590 03/08/2004

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

MEHTA, ASHWIN D

ART UNIT	PAPER NUMBER
----------	--------------

1638

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SA
Advisory Action

Application No.

09/812,283

Applicant(s)

FISCHER ET AL.

Examiner

Ashwin Mehta

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 8 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 30 January 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: 8, 17, 19 and 29.

Claim(s) rejected: 1, 2, 5-7, 9, 10, 12, 13, 15, 18 and 20-28.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet


ASHWIN D. MEHTA, PH.D
PATENT EXAMINER

Continuation of 3. Applicant's reply has overcome the following rejection(s): the obviousness-type double patenting rejection, the rejection of claims 2 and 15-29 under 35 U.S.C. 112, 2nd paragraph, and the objection to claim 1.

Continuation of 5. does NOT place the application in condition for allowance because: Applicants' response does not overcome the rejections of claims 1, 2, 5-7, 9, 10, 12, 13, 15, 18, 20-28 under 35 U.S.C. 112, 1st paragraph. Regarding the lack of written description rejection: Applicants reiterate the same argument raised in their previous response, that the pending claims comply with the written description requirements as set forth in *University of California v. Eli Lilly & Co.* by providing a shared structural feature (encoding a polypeptide that has at least 60% identity to SEQ ID NO: 4 and has a WD40 repeat) and functional feature (capable of enhancing endosperm development in the absence of fertilization in a plant when introduced under a promoter)(response, page 6, last paragraph). This was not found persuasive for the reasons stated in the Office action mailed July 31, 2003. Applicants also argue that while the presence of the WD40 repeat alone does not confer functionality, its combination with the specified percentage does (response, page 6, last paragraph). However, the specification does not disclose any such sequences. To address this, Applicants submit post-filing art, Springer et al. which allegedly describes the structures of two maize genes that encode amino acid sequences having 68% and 58% identity with FIE, and identifies them as homologs of Arabidopsis FIE (response, page 7, 1st full paragraph to the paragraph bridging pages 7-8). However, as the reference, and the sequences disclosed within, were not known in the art at the time of filing of the instant application, they cannot be considered.

Regarding the scope of enablement rejection: Applicants again argue that the specification provided sufficient disclosure regarding specific motifs (the WD40 motif) and relationships with known proteins for those of skill in the art to make and use the sequences within the full scope of the claims (response, page paragraph bridging pages 8-9). However, as discussed in the previous Office action, the prior art teaches other proteins comprising the WD40 motif that do not have the same function as SEQ ID NO: 4. The specification does not teach what other sequences of SEQ ID NO: 4 are essential for its functional activity, and which amino acids can be changed without affecting activity. Applicants also again cite Springer et al. for identifying FIE homologs that allegedly have less than 40% divergence allowed for in the present claims (response, paragraph bridging pages 8-9). However, again, Springer et al. was published after the filing of the instant application, and cannot be relied upon by Applicant for support of enablement. A disclosure in an application, to be complete, must contain such description and details as to enable any person skilled in the art or science to which the invention pertains to make and use the invention as of its filing date. In re Glass, 492 F.2d 1228, 181 USPQ 31 (CCPA 1974).

Continuation of 10. Other: Claims 8, 17, 19, and 29 are objected to for being dependent upon a rejected base claim..